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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,134	11/07/2001	Patricia A. Torrens-Burton	ROC920010138US1	2360

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IBM Corporation
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EXAMINER	
FISHER, MICHAEL J	

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/045,134	TORRENS-BURTON, PATRICIA A.	
	Examiner	Art Unit	
	Michael J. Fisher	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 25 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In section (b) is the limitation, "a signal bearing media..." a possible variation of this being described in the specification of the instant application, on page 14 thereof, "Examples of signal bearing media include...digital and analog communications links." A transmitted signal is non-statutory for 35 USC 101 purposes.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 6- 9,11,12, 14-19, 21-23 and, as best understood, 25 are rejected under 35 U.S.C. 102(e) as being anticipated by US PAT 6,892,388 to Catanoso.

As to claim 1, Catanoso discloses a method of providing souvenir images (col 1, lines 52-54) comprising: capturing an image of an event (col 1, lines 52-54), receiving

desired location information from the customer (inherent in that the desired images are sold to the customer, col 6, lines 12-14), displaying the image (at playback station 60).

As to claim 11, Catanoso discloses generating a plurality of images (inherent in that a video clip is comprised of a plurality of video images), receiving location information from the customer (col 6, lines 12-14), and providing the image to the customer (inherent in that the customer is provided that which is purchased, col 6, lines 12-14).

As to claim 16, Catanoso discloses a selection input device (playback workstation 60), a processor (inherent in that the system uses a computer for which a processor is necessary, fig 1) and an image delivery apparatus (that which produces the CD-ROM, col 2, lines 4-6).

As to claim 2, the image is provided to the customer (col 6, lines 12-14).

As to claim 3, the image is electronic (col 5, lines 2-3, digitized being electronic).

As to claims 6,23, the image is a video clip (col 3, lines 32-38).

As to claims 7,14, the image is a printed photograph (col 5, lines 33-37).

As to claim 8, it would be inherent that the desired location is correlated with the event site location (else the video could not be captured).

As to claims 9 and 12, the souvenir is purchased (col 6, lines 12-15).

As to claim 15, the image is written on a signal bearing media (CD-ROM, col 2, lines 4-6).

As to claim 17, the playback workstation (60) would be a "kiosk".

As to claim 18, the printer (col 5, lines 33-37) would inherently and necessarily be operably connected to the kiosk else the printer would not know which image or images to print.

As to claim 19, a CD-ROM is an optical disc as it uses lasers.

As to claim 21, the system is connected to a computer network (fig 1 shows the network).

As to claim 22, Catanoso discloses a stadium display unit (playback workstation 60).

As to claim 25, as best understood, as the method as claimed is done by Catanoso, as discussed in the above rejection, and further as it is done by a computer (fig 1), it would inherently be a computer program product.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 4,5,10,13,20 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Catanoso.

Catanoso discloses a method and system and computer product as discussed above.

As to claim 4, Catanoso does not disclose the image as being of a scoreboard display. Catanoso does, however, teach the system as being used at an athletic event (col 5, lines 44-47). Therefore, it would have been obvious to one of ordinary skill in the art to include images of a scoreboard to memorialize important events that would be displayed on the scoreboard, such as: Final score or an important milestone like an important event (such as a famous player's $3,000^{th}$ hit).

As to claim 5, Catanoso does not teach the image as comprising a television broadcast image. Catanoso does teach the system as being used at events that are televised (such as an athletic event as discussed in relation to claim 4). Therefore, it would have been obvious to one of ordinary skill in the art for the image to comprise a television broadcast as ballparks already contain many television cameras for broadcast to an audience and using already installed cameras that are used to capture as much action as possible would be less costly than requiring a myriad of new cameras.

As to claim 10, it would have been obvious to one of ordinary skill in the art to use seat number from the customer so as to include an image of the customers at the event in their seats.

As to claim 13, Catanoso does not teach using electronic mail as the method to provide the customer with the souvenir. Catanoso does teach using a computer (fig 1) and saving the video in AVI format (a tagged and compressed format, col 3, lines 65-67). The examiner takes Official Notice that sending video clips in AVI format through electronic mail is old and well known in the art and further, the examiner takes Official notice that it is old and well known to connect computers to the Internet and therefore, it would have been obvious to one of ordinary skill in the art to send the images via electronic mail to make the souvenir cheaper as the customer would not have to pay for the production of a CD-ROM or other media carrying device.

As to claim 20, Catanoso does not teach the input method for the computer. The examiner takes Official Notice that touch screen monitors and keypads are old and well known as input devices for computers. Therefore, it would have been obvious to one of ordinary skill in the art to use a touch screen monitors and keypads as these are well known to most computer users and would not require training for the customer that more esoteric devices might require.

As to claim 24, Catanoso discloses a camera capturing a plurality of images (col 4, lines 48-50), receiving payment (inherent in that the souvenir is purchased, col 6, lines 12-14) so there would inherently be a "payment receiver" and printer (col 5, line 36), the system inherently would correlate the images with the location else the customer could receive the wrong image. Catanoso does not, however, teach how to receive the payment, a ticket reader or taking images related to the seat. It would have been obvious to one of ordinary skill in the art to use seat number from the customer so

as to include an image of the customers at the event in their seats and further to use a ticket reader as this would ensure that an improper seat number was not entered.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Fisher whose telephone number is 571-272-6804. The examiner can normally be reached on Mon.-Fri. 7:30am-5:00pm alt Fri. off.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael J. Fisher

Patent Examiner
GAU 3629

MF
12/8/05